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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/020,759
Filing Date: December 13, 2001
Appellant(s): GALLOWAY, RICHARD L.

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GROUP 3600

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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 16, 2006 appealing from the Office Action mailed June 19, 2006 (herein the "OA").

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences .

The Examiner believes copending Application No. 09/947,730 presently on appeals before this Board has a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5701451   Rogers et al   12-1997

Specifications of the instant application (in support of admitted art)

Specifications of copending Application No. 09/947,730 (in support of admitted art).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   *Claims 1-17, 19-27, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted art in view of Rogers et al, US 5701451 A.*

As to claims 1-2, and 4:

communicating a timing of ad broadcasts by accessing at least one electronically stored record indicating times for ads broadcast in a (past) period;

generating a client report including at least a time for a broadcast of an ad in a period; and

transmitting the report to an advertising client **is admittedly known to be done manually (Specifications page 2, Fig 1A).**

Further accessing an electronically stored record generated at least in part by broadcast inserter equipment and accessing an electronically stored record generated at least in part by a traffic and billing system manually is also **admittedly known (Specifications [0005] to [0008], Fig 1A).**

Transmitting such report by fax is **also admittedly known (Specifications, PGPub version, US*20020095339, at* [0005] to [0008], Fig 1A).**

However, it is not admitted the above steps are automated.

However, it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner,* **262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).** For example, simply automating the step of culling the needed information and manipulating the data to produce the report automatically as claimed gives you just what you would expect from the manual step as admitted. In other words there is no enhancement found in the claimed steps. The claimed steps above only provide automating the manual activity. The end result is the same as compared to the manual method. A computer can simply produce the report faster. The result is the same.

It would have been obvious to a person of ordinary still in the art at the time of the invention to automate the above discussed steps because this would speed up the process of producing a report for clients, which is purely known, and an expected result from automation of what is known in the art.

Further, Rogers discloses:

A World Wide Web browser makes requests to web servers on a network which receive and fulfill requests as an agent of the browser client, organizing distributed sub-agents as

distributed integration solution (DIS) servers on an intranet network supporting the web server which also has an access agent servers accessible over the Internet. DIS servers execute selected capsule objects which perform programmable functions upon a received command from a web server control program agent for retrieving, from a database gateway coupled to a plurality of database resources upon a single request made from a Hypertext document, requested information from multiple data bases located at different types of databases geographically dispersed, performing calculations, formatting, and other services prior to reporting to the web browser or to other locations, in a selected format, as in a display, fax, printer, and to customer installations or to TV video subscribers, with account tracking (abstract).

Thus Rogers discloses electronically grabbing information from multiple sources and formatting the information in any way desirable, which is the equivalent of Applicant's reporting step as a report is essentially a form. Thus the technology capable of doing the automated step of an admittedly known manual step is available, which lends support to the application of In re Venner in this instance.

NOTE:

As to the accessed data in claim 1 being "times", it is noted these claimed data are non-functional descriptive material, because it is not claimed what is done with that data after the steps of accessing (which logically includes identifying). Claim 1 boils down to accessing a database record, generating a report from accessed data, and then transmitting the report. Further, the accessed records including time for a broadcast of an ad are either explicitly or implicitly admitted (see [0005] and [0006] "scheduled times and locations for ad airing").

Further it also noted, as to claim 2, that the system being called a "traffic and billing" system also is not given weight because the name of the system does not impact the method step as well. *Ex parte Pfeiffer (see more details below).*

As to claim 3, automatically generating and transmitting a plurality of reports is obvious if many advertiser clients or different ad campaigns for the same client are involved to make each report relevant to the subject matter/client.

As to claim 5, including an ad in a communication with a client is well-known, such as including a logo or a company motto, to remind the client of the nature and/or quality of one's service or to apprise of a discount, thus including an advertising banner in a transmission of the report in this case, would have been obvious for the same marketing reasons.

As to claim 6, "an account manager for the client" is not given patentable weight as the title of the recipient does not impact the method step.

See Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961), which held that, "to be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure". In this case, there does not seem to be any impact on the manipulative steps of the method because of the name of the recipient, similar to the reasoning in Ex parte Pfeiffer.

As to claim 19 (dependent on claim 1), generating a report including a title of an ad would have been obvious to indicate which ad it relates to.

As to claims 7-16, it is admitted "traffic and billing programs" to schedule ads or spots for one or for a variety of media at a variety of times and possibly a variety of geographical locations over a designated period for a set of advertising clients, as per the clients' contracts are well-known. A traffic and billing system, at least shortly before a designated period begins, produces a record (such as a Schedule Log or an Event Log and/or an Inserter Log) of all scheduled spots for ads on the set of media the communications company manages within a next designated period. Specifications at [0039]. Thus "compiling a schedule log" is admittedly well known. Also see Specifications at [0052].

Further verification logs or (verified files logs) are admittedly typically produced by a system's commercial insertion equipment and returned to a traffic and billing system. Specifications at [0011], [0073], FIG. 1B.

Further, a verified file is admittedly "typically assumed to be associated with a version of a Schedule Log, indicates times that each ad was actually run. If an ad for whatever reason was not run, that too is indicated." Specifications at [0073]. Thus "outputting a measure of the effectiveness of a broadcast media in executing advertising in accordance with schedule log being an indicia of an omitted ad" is admittedly known.

Accessing a schedule log, compiling a schedule report, and transmitting the report to advertisers clients admittedly has been done manually. As discussed above, automation of manual processes (compiling the report) is not patentable in view of In Re Venner and Rogers, as discussed above.

As outputting a measure of the effectiveness of a broadcast media in executing advertising in accordance with schedule log being an indicia of an omitted ad is admitted known, it would have been obvious to one skilled in the art at the time the invention was made to also add this data to the report in order to apprise the client of the success of the insertion and/or the reasons of non-insertion. Specifications at [0073]. Again, as to this additional data, Rogers also shows the capability of grabbing this information to automate manipulation and reporting of the data as desired.

Further, reporting for each advertising client is obvious to make sure the report is addressed to the right client.

Further, automatically generating and transmitting a plurality of reports is obvious if many advertiser clients are involved to serve all these clients.

As to claim 17, it is admitted the manual reporting procedures apply both to advance notice of ads to be run as well as "as run" ads. Specifications [0006]. It would have been obvious to one skilled in the art at the time the invention was made to add transmitting a schedule report prior to a broadcast to the automatic reporting of as-run ads method so far discussed, to add further value to the automatic reporting (of as-run ads) method by providing automatically and efficiently advance notice of ads to be run. Since it is admitted the relevant needed data (for as run ads and for advance notice) are readily available for report compilation, if desired, and has been so done manually, it would have been obvious to one skilled in the art at the time the invention was made to do the same automatically for the obvious efficiency advantages.

As to claim 20, as to the accessed data, being "media, times, client and title" it is noted those claimed data are non-functional descriptive material because it is not claimed what is done with that data after the steps of accessing (which also logically includes identifying). Claims 7 and 13 boil down to accessing a database file, generating a report from accessed data, then transmitting the report. Further the accessed records including media, time, and titles of the ad are either explicitly or implicitly admittedly known (see [0005],[0006] "scheduled times and locations for ad airing") .

Further, as to claim 20, the data being created by "different" systems does not impact the positive step of identifying such data, thus "created by different... systems" is not entitled to patentable weight. See Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961), which held that, "to be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure". In this case, there does not seem to be any impact on the manipulative steps of the method because of the number of systems involve which creates the data before they are later accessed/identified. (It is noted however that Rogers teaches grabbing data from many data sources, so even if "created by different... systems" is given patentable weight, the admitted art in view of Rogers disclose the method of claim 20).

As to claims 21-26, 27-28, the limitations of these claims that are common to the previous claims are rejected as discussed above. Further ratings service files, such as Nielson ratings, are admittedly known and typically transmitted to broadcasters by media the subsequent day. Specifications at [0011] and [0072].

It would have been obvious to one skilled in the art at the time the invention was made to add Nielson ratings to the report to provide clients with further additional valuable information. Again, as to this additional data, Rogers also shows the capability of grabbing this information to automate manipulation and reporting of the data as desired.

As to claims 29 and 30, the admitted art does not disclose posting the report on a website on the internet for client access, but Rogers discloses "prior to reporting to the web browser or to other locations, in a selected format,... as in a display, fax, printer, and to customer installations", thus Rogers clearly shows reports shown on websites for client access. It would have been obvious to add such a feature of Rogers to the admitted to conveniently present the reports to
clients as disclosed by Rogers (abstract).

The following response to arguments, presented in the Office Action dated 04/06/2006, is an integral part of the grounds of rejection.

"8.   Preliminary matters:

<u>*What is admitted in the Specification:*</u>

Applicants argue the specification does not admit that "electronically accessing" records of a traffic and billing system is known. However Applicants now state that some traffic and billing systems can download i.e. print certain reports. It is first noted that "download" means in computer science "to transfer (data or programs) from a server or host computer to one's own

computer or device" per <u>dictionary.com</u>. To restrict the plain meaning of "download" now to
only printing is adding new matter to the specifications. Further it is noted that even if
"download" means "print", getting records from such systems via an electronic printer requires
"electronically accessing" such records first to send to the printer. Further again at
specifications page 2, lines 19-21" it is disclosed "The instant system is adapted to
automatically electronically communicate <u>with an electronically stored record o ads scheduled</u>
<u>to be "aired", typically created by one of a variety of "traffic and billing systems" or their</u>
<u>equivalent."</u>_(underline emphasis) added. Thus an electronically stored record is available to be
accessed electronically, even via printers.

The person of ordinary skill:

Applicants argue the person of ordinary skill in the instant art would be an "operations and
traffic manager" and that such manager would not know to do all the electronic accessing of
records, etc..., to do so in a safe manner, as argued at page 3 last paragraph. The Examiner
disagrees that such an OPERATIONS AND TRAFFIC manager is the person of ordinary skill
in the art in this instance. Rather, it would be one skilled in computer software and hardware
and familiar with the known systems.

MPEP 2141.03 state FACTORS TO CONSIDER IN DETERMINING LEVEL OF
ORDINARY SKILL. They include (1) the educational level of the inventor; (2) type of problems
encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which
innovations are made; (5) sophistication of the technology; and (6) educational level of active
workers in the field." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 696, 218
USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The "hypothetical person
having ordinary skill in the art to which the claimed subject matter pertains would, of necessity
have the capability of understanding the scientific and engineering principles applicable to the
pertinent art." Ex parte Hiyamizu, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter.1988).

Here, Rogers shows evidence of the level of skill in the art, in the sophistication of the
technology of pulling data from diverse sources. Further, on page 12, in reference to "copying

and failure of others", Applicants state that another programmer worked on the problem of producing the reports, though he was unsuccessful at producing a working report program, where on the other hand, the inventor was successful. That is further evidence that such programmer is a person skilled in the art, and not an OPERATIONS AND TRAFFIC manager.

9.   Matters of Law:

Applicants argue Rogers is non-analogous art. However, "a prior art reference is **analogous** *if the reference is in the field of applicant's endeavor or, if not, the reference is* **reasonably pertinent** *to the particular problem with which the inventor was concerned." In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Also, "Section 103 requires us to presume that the artisan has full knowledge of the prior art in his field of endeavor and the ability to select and utilize knowledge from analogous arts." Lamont v. Berguer, 7 USPQ2d 1580 (BdPatApp&Int 1988).*

Rogers is analogous art because one faced with the problem of pulling data from different sources as faced by the inventor, would look to the solutions presented by workers in the computer field such as Rogers.

Applicants argue Rogers does not teach how to reach into and retrieve data from any system. This is clearly not the case. Rogers discloses "...DIS servers ... retrieving, from a database gateway coupled to a plurality of database resources ..., requested information from multiple data bases located at different types of databases geographically dispersed, performing calculations, formatting, and other services prior to reporting to the web browser or to other locations, in a selected format, as in a display, fax, printer, and to customer installations .,.with account tracking. " (abstract). Thus Rogers clearly teaches reaching into different databases of many systems to retrieve the requested data.

Further, the instant claims do not claim how to reach into and retrieve data in any details either, thus the argument is unpersuasive. The instant claims do not even claim pulling records from traffic and billing system software specifically, thus again the attacks on Rogers, on page 6, 3rd full paragraph, are unpersuasive.

Applicants further argue that there is not per se automation rule based on In Re Venner. Assuming without presently conceding that Applicants assertions are correct, it is noted however that, in addition to In Re Venner, Rogers discloses the required automation steps. Indeed Rogers discloses, ...DIS servers ... retrieving, from a database gateway coupled to a plurality of database resources ...,requested information from multiple data bases located at different types of databases geographically dispersed, performing calculations, formatting, and other services prior to reporting to the web browser or to other locations, in a selected format, as in a display, fax, printer and to customer installations .... " (abstract). Thus Rogers clearly teaches <u>automatically</u> (i.e. by computer) and <u>electronically</u> grabbing information from multiple sources and formatting the information in any way desirable, which is the equivalent of Applicant's automatic reporting steps (since a report is essentially a form).

Applicants further argue that Ex Parte Pfeiffer has been effectively overturned by In Re Ochiai, In Re Brouwer. Applicants cite MPEP 2116 in support. The Examiner notes that MPEP 2116 deals with "<u>materials on</u> which a process is carried out" and MPEP 2116.01 which cites In Re Ochiai, In Re Brouwer deals "Novel, Unobvious Starting Material or End Product", i.e. all chemicals/ and materials cases.

Thus it seems the facts of the cases cited in MPEP 2116 may not apply to the instant application. Further, even assuming that Applicants are correct in their analysis that In Re Ochiai, In Re Brouwer effectively overrule Ex Parte Pfeiffer, it is noted now and stated before, however, that "Rogers teaches grabbing data from many data sources, so even if "created by different... systems" is given patentable weight, the admitted art in view of Rogers disclose the method of claim 4." In other words, a per se rule alone was not applied in this case, since Rogers was applied as secondary reference.

10.   Arguments regarding the 35 USC 103 rejections:

In arguing the synergistic value of automation both to inserters and to client advertisers, at page 8, Applicants seems to suggest the references must be combined for the same purpose as

contemplated by the inventor. However, although the references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103, since the references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results." In re Gershon, Goldberg, and Neiditch, 152 USPQ 602 (CCPA 1967). "...law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "In re Beattie, 24 USPQ2d 1040 (CA FC 1992).

As to claim 6, nothing in the specifications require an interpretation that "an account manager for the client" is an in-house person, and such a transmission of data is an in-house one, absent specific definitions. Applicants are reminded of the broadest interpretation rule. Nothing is claimed what this person will do with the information once he/she receives it so the argument as to what this person might influence is unpersuasive. Even if "an account manager for the client" is given weight, it would be just be interpreted as a person having some working relationship with the client, in-house or outside. It is admitted that such a person having some working relationship with the client receives report information manually (disclosure page 2). As the admitted art in view of Rogers discloses automatic transmission of reports, it would have been obvious to automatically transmit to this same person as was done manually as well for the same reasons: informing the relevant person.

*At pages 8-9, Applicants further seem to argue the collateral benefit of selling upgraded contracts warrants patentability. However, Applicants do not cite any precedent in support. Further it is noted the **claiming of a new use, new function or unknown property** which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430,433 (CCPA 1977). See MPEP 2112. Here selling upgraded contracts may just be an obvious result of the improved communication with clients, which is a natural result from automatic generation of client reports. As stated earlier automating the manual activity of generating client reports by computer just makes the*

generation faster. It is natural that providing more requested reports faster will make clients happier.

With regards to Nielson ratings, while they may enhance the Applicant's proposed invention, these ratings are admittedly known and typically transmitted to broadcasters by media the subsequent day. Specifications at [0011] and [0072].

It would have been obvious to one skilled in the art at the time the invention was made to add Nielson ratings to the automated "as run" report to provide clients with further additional valuable information. Again, as to this additional data, Rogers also shows the capability of grabbing this information to automate manipulation and reporting of the data as desired.

The examiner disagrees with all the traverses of admitted art raised by Applicants. The admissions are on their faces as set forth above.

11. Affidavits and secondary evidence of non-obviousness:

The Examiner has given all due consideration to the affidavits submitted in the instant case, but regrettably they remain unpersuasive to rebut the prima facie case of obviousness. MPEP 716.01 (a) requires objective evidence and proof of secondary considerations facts for the evidence to be of probative value. The affidavits do not provide such objective evidence or proof of secondary considerations facts.

Per MPEP 716.01(b) a nexus is required, between the merits of the claims and the evidence of secondary considerations. Here, the full scope or breadth of the claim language is not covered by the affidavits. The Affidavits seem to track the problem solved and arguably a preferred embodiment instead of the broad claim language. As stated below, the instant inventor's program may be successful in the particular code he uses which is not claimed and not in the broad methods that are now claimed.

MPEP 716.01 (c) requires the evidence of secondary considerations facts to be of probative value. The affidavits do not provide such objective proof that the methods herein claimed are the reason of the success.

MPEP 716.01(d) requires consideration in light of the full record. Regrettably, the submitted affidavits do not overcome the facts of the prima facie case.

Further, at page 12, regarding "copying and failure of others", Applicants state that another programmer worked on the problem of producing the reports, though unsuccessful at producing a working report program while the inventor was. That is evidence that such programmer is a person skilled in the art. Applicants also state the competitor programmer is to recreate the prototype (created originally by the inventor), thus implying that, if the inventor is successful, it may be in the particular program code he came up with. Such code is not claimed. Thus all this evidence of failure of others is unpersuasive. "

(10)   Response to (Brief's) Arguments

Applicants traverse the rejection of Claims 1-17, 19-27, and 29-30 under 35 U.S.C. 103(a) as being unpatentable over admitted art in view of Rogers et al, US 5701451 A.

In response, it is reiterated that, as to independent claim 1, as stated during prosecution, it is admitted as known:

electronically accessing (the traffic and billing system (TBS) inherently accesses theses records it creates in order to produce the report) an electronically stored record indicating, directly or indirectly, at least media, times and titles for broadcast ads for a future designated period (see Specifications page 2, lines 19-22 : records created by TBS of ads to be aired; lines 11-13: scheduled times /site (media) report produced by TBS; p. 6 l. 4-7;8p. 10 lines 21-23: internet application).

electronically generating (generated by the TBS) a client report (report including scheduled time / site (= media) per client , Specs p. 2 l. 11-13 , page 6 lines 22-23, see Fig 1A) for a plurality of a broadcast media's advertising clients (Fig 1A) including at least a time for a broadcast of an ad in a future period (Specs p. 2 l. 5-6) ; and

electronically transmitting (transmitting by fax) the report to the clients prior to broadcast (Specifications page 2 lines 14-15, Fig 1A).

However, it is not admitted the above steps are <u>automated</u>.

However, it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

For example, simply **automating the step of culling the needed information and manipulating the data to produce the report automatically** as claimed gives you just what you would expect from the manual step as admitted. In other words there is no enhancement found in the claimed steps. The claimed steps above only provide automating the manual activity. The end result is the same as compared to the manual method. A computer can simply produce the report faster. The result is the same.

It would have been obvious to a person of ordinary still in the art at the time of the invention to automate the above discussed steps because this would speed up the process of producing a report for clients, which is purely known, and an expected result from automation of what is known in the art.

*(NOTE: in claim 1: "media, times and titles" are **non-functional descriptive material** because it is not claimed what is done with that data after the steps of accessing (which also logically includes identifying ; further **generating in the 2nd step is interpreted as formatting the data into a report**).*

<u>Thus as stated earlier, Claim 1 boils down only to accessing a database record, generating a report from accessed data, then transmitting the report.</u>

Further evidence that that's all the invention is about is in the specifications at p. 10 last paragraph as to an internet application: the TBS produces a schedule of planned locations (media), times, for ads. The claimed invention (AirCheck program) only accesses such data (schedule), and repackage into a report giving locations, timing, ad, per advertiser and transmits the report via fax/email/or posted to a website.)

Further, as stated earlier and above, Rogers discloses:

A World Wide Web browser makes requests to web servers on a network
which receive and fulfill requests as an agent of the browser client,
organizing distributed sub-agents as **distributed integration solution**
(DIS) servers on an intranet network supporting the web server which
also has an access agent servers accessible over the Internet. **DIS**
servers execute selected capsule objects which perform programmable
functions upon a received command from a web server control program
agent for retrieving, from a database gateway coupled to a plurality of
database resources upon a single request made from a Hypertext document,
requested information **from multiple data bases located at different**
types of databases geographically dispersed, performing calculations,
formatting, and other services prior to reporting to the web browser or
to other locations, **in a selected format, as in a display, fax, printer,**
and to customer installations or to TV video subscribers, **with account**
tracking (abstract).

Thus Rogers discloses electronically grabbing information from multiple sources and formatting the information in any way desirable (col. 5 lines 28-34), which is the equivalent of Applicant's reporting step as a report is essentially a form. **Thus the technology capable of doing the automated step of an admittedly known manual step is available, which lends support to the application of In re Venner in this instance.**

It is noted that Rogers discloses means for accessing database records (abstract; col. 5 lines 10-34; Fig. 7 : DIS Server with DIS capsule program), means for generating a report from accessed data (col. 5 lines 10-34: both reformulating and formatting; Figs 9-10; col. 8 lines 44-47).and means for transmitting the report (abstract; col. 5 lines 10-34; Figures 4, 6 and associated text; col 8 lines 22-26).

Thus Rogers's DIS is equivalent to Appellants' Aircheck program.

Person of Ordinary Skill in the Pertinent Art (Brief's argument C, pages 8-10)

At pages 8-9 of the Brief, Applicants argue the **Person of Ordinary Skill** is a person in the position of an operations manager for broadcast media. The Examiner disagrees. Rather it would be one skilled in computer software and hardware and also familiar with the known (TBS) systems. The educational level of the inventor is but one factor to determine the level of ordinary skill.

First, regarding "copying and failure of others", Applicants state that another programmer worked on the problem of producing the reports, though unsuccessful at producing a working report program, while the inventor was. That is further evidence that at least such programmer is a person skilled in the art, not an OPERATIONS AND TRAFFIC manager.

Second, if Applicants mean to argue that the disclosure in Rogers, (for lack of a mention of TBS systems), would not permit one faced with records from a TBS to use Rogers, the issue becomes then: **what is the level of ordinary skill when plural arts are involved such as in the instant case, the broadcasting art (the admitted art in this case) and the computer art (Rogers)?**

It has been held, when the invention involves two different technological arts, in enablement issues, that the sufficiency of the disclosure must be judged from the standpoint of a person having ordinary skill <u>in both arts</u>. **In re Brown, 477 F.2d 946, 950-51, 177 USPQ 691, 694 (CCPA 1973)** (where the invention involves two different technologies, the sufficiency of the disclosure is to be judged in terms of a person having ordinary skill in both technologies) (citing **In re Naquin, 398 F.2d 863, [866,] 55 CCPA 1428 [158 USPQ 317, 319] (1968))**.

In re Brown involves enablement issues however the same reasoning should be applied, conversely, in judging the level of ordinary skill when the invention involves two different technological arts, as in the instant case.

In other words if the prior art references sufficiently describes so that skilled artisans in the respective arts can use them, then when the invention involves two different technological arts, as in the instant case, the level of ordinary skill should be that of a person having ordinary skill <u>in both arts</u>.

Third, what is then the appropriate level of skill?

It is well-settled, the prior art (Rogers) itself reflects an appropriate level of skill. See *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Oklahoma v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001). MPEP 2141.03. And the level of ordinary skill shown in Rogers is high.

(Rogers also shows the sophistication of the technology of pulling data from diverse sources across many networks and electronic platforms. Rogers is involved with information technology (IT) where the operating level of competition and innovation is very high and involves the talents of hundreds of thousands of creative engineers worldwide. It has been said that in information technology, convergence and integration are taken for granted. Therefore those having ordinary skill in the art in the IT industry are highly creative and possess high problem-solving skills.

In IT, the rapidity with which innovations are made is high; the sophistication of the technology is high; and the educational level of active workers in the field is high.

With this high level of skill, it would have been obvious to one skilled in the art at the time the invention was made to apply the methods of Rogers to solve the instant automation challenge posed in the TBS systems. The "hypothetical 'person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art." *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988).

Fourth, Applicant provided no evidence nor provided any support or argument for why reasonable success would not have been expected in the combination of admitted art and Rogers as proposed by the Examiner. The schedule log records produced by the TBS system are just records residing in a database. **Rogers teaches accessing records from any and/or many database (s), manipulate and repackage data therefrom as desired and send report thereof in the format/ content as desired. It is well within the level of ordinary skill in the art (as shown by Rogers) to accomplish the modification proposed by the Examiner. Applicants have not shown how the schedule logs produced by the TBS system would be different from any other electronic records so that the Rogers DIS servers cannot access, manipulate or reformat.**

Argument A (page 6 of the Brief).

Meaning of "accessing" in contrast to "downloading" used in the prior art.

At page 6, Applicants argue downloading is not 'electronically accessing" thus "'electronically accessing" records is not admitted as known.

In response, the Examiner notes as done earlier:

first, to "download" means in computer science *"to transfer (data or programs) from a server or host computer to one's own computer or device"* per dictionary.com.

second, even if "download" only means "print" as argued, getting records from such systems via an electronic printer requires "electronically accessing" such records first to send to the printer.

third, the specifications of copending application 09/947730 , at page 2, lines 19-21 and the instant Specifications at ([0007] or page 2 lines 22-25) disclose *"The instant system is adapted to automatically electronically communicate <u>with an electronically stored record of ads scheduled to be "aired", **typically created** by one of a variety of "traffic and billing systems" or their equivalent</u>."* (underline emphasis) added.

Also see the instant Specifications (at [0004]-[0006]), specifically at [0005]: *"The person would then typically manually request a "traffic and billing system" (or some equivalent) to download a scheduled time/site report or verified run report for or including that client."*

Thus an electronically stored record is admitted as being <u>typically</u> available to be accessed electronically.

In sum, in order to produce a report by the TBS as admitted, the TBS inherently pulls such original data, thus "electronically access" of the records by the TBS system is admitted.

(Note: A downloaded "scheduled time/site report" clearly is compiled from the traffic and billing system (TBS) schedule log records as disclosed in [0004] above.

As discussed above and during prosecution downloading records means electronically accessing them therefore "electronically accessing a schedule log" is admitted as known.

Applicants had argued there's no structure that is admitted as known to be in communication with the schedule log. This amounts to attacking the rejection as if anticipation was the basis thereof. The rejection was based on unobviousness under 35 U.S.C. 103(a). Thus references cannot be attacked individually. As stated above, Rogers provides all the structures and means necessary to carryout the automation of an admittedly known manual process.

(As noted above, Rogers discloses means for accessing database records (abstract; col.
5 lines 10-34; Fig. 7: DIS Server with DIS capsule program), means for generating a report
from accessed data (col. 5 lines 10-34: both reformulating and formatting; Figs 9-10; col. 8
lines 44-47) and means for transmitting the report (abstract; col. 5 lines 10-34; Figures 4, 6
and associated text; col. 8 lines 22-26). *Thus Rogers's DIS is equivalent to Appellants'*
Aircheck program.)

Thus, Rogers provides all the means for automatically electronically compiling a client
report from admittedly known readily available schedule log records.

At page 6, it is also argued "electronically access" is "to enter and to use", "to interpret",
to extract information, to "parse data*", to recognize and read", to "copy and cull data".*
However, "electronically access" is not specifically defined as such. Nor are all the terms
argued above claimed.

Further even if "electronically access" means all the above, and even if the instant
invention "directly accesses" data records and that makes some difference as further argued
(Brief, page 11, end of 1st full paragraph) Roger, at col 5 lines 28-44, specifically discloses all
such, by disclosing directly "accessing data" for manipulation and calculation purposes:

"Our invention provides a method and system for allowing a user of a client

to access and assemble information structured and reported to the user in

accordance with his desires, selecting information for disparate servers which

are located within a network can be an intranet or internal network such as a

LAN or WAN not normally accessible to the Internet, or coupled to the Internet.

In accordance with our invention one can access data on multiple databases of

different types using a single user request from a client. We also allow the

facility for providing specialized specific requests to be created for routine

use, as well as the facility to formulate generalized or specialized ad hoc

requests. In addition, we provide besides query and update capability, the

ability to perform calculations with respect to any retrieved data, to format

the information in text or in graphics, and the facility of presenting the

results to the client for display or other use".

It is also argued the prior art does not disclose automatically distributing a result. Rogers

actually does, as cited above:" *presenting the results to the client for display or other use."*

Argument B(Brief page 6-8) : the kinds of records in the instant application are different from the records disclosed in Roger.

In response Applicants are referred to the discussion of the level of skill when 2 areas of

technologies are involved and the level of sophistication in the art evidenced by Roger (see pages

18-20 above) and to what the skilled in the art are legally presumed to know in view of the prior

art of record (see discussion pages 28-30 below).

Rogers teaches pulling data from diverse sources across many networks and electronic platforms

for manipulation (col 5 lines 28-44, cited above). Web serves and 'gateways" are just one

application of Rogers. Rogers is applicable to any type of network including an intranet. A TBS

system is analogous to an intranet therefore Rogers should be able to handle its data.

Applicants have not shown how the TBS data, albeit "record indicating times of ads for.

broadcast in a past period", are different that a sophisticated IT worker in view of Rogers cannot

design necessary software modules to handle them.For example separate software modules can

be designed between the TBS and the reporting system to exchange information either directly or

by means of uploadable data files. This and other programming alternatives are within the scope

of the Rogers teachings.

Claim Limitations to be Given patentable weight and No per se rule re. Automation (Brief, Argument D, pages 10-11)

At page 10 of the Brief, Applicants argue no Per se rule re Automation.

The Examiner has answered this argument at OA page 17-18: **in fact a per se rule was not applied.**

"Applicants further argue there is not per se automation rule based on In Re Venner. Assuming without presently conceding that Applicants assertions are correct, it is noted however that, in addition to In Re Venner, Rogers discloses the required automation steps. Indeed Rogers discloses, "...DIS servers ... retrieving, from a database gateway coupled to a plurality of database resources ...,requested information from multiple data bases located at different types of databases geographically dispersed, performing calculations, formatting, and other services prior to reporting to the web browser or to other locations, in a selected format, as in a display, fax, printer and to customer installations ...." (abstract). Thus Rogers clearly teaches automatically (i.e. by computer) and electronically grabbing information from multiple sources and formatting the information in any way desirable, which is the equivalent of Applicant's automatic reporting steps(since a report is essentially a form).

... Applicants further argue that Ex Parte Pfeiffer has been effectively overturned by In Re Ochiai, In Re Brouwer. Applicants cite MPEP 2116 in support. The Examiner notes that MPEP 2116 deals with "materials on which a process is carried out" and MPEP 2116.01 which cites In Re Ochiai, In Re Brouwer deals "Novel, Unobvious Starting Material or End Product", i.e. all chemicals/ and materials cases.

Thus it seems the facts of the cases cited in MPEP 2116 may not apply to the instant application. Further, even assuming that Applicants are correct in their analysis that In Re Ochiai, In Re Brouwer effectively overrule Ex Parte Pfeiffer, it is noted now and stated before, however, that "Rogers teaches grabbing data from many data sources, so even if "created by different... systems" is given patentable weight, the admitted art in view of Rogers disclose the

*method of claim 4." **In other words, a per se rule alone was not applied in this case, since**
Rogers was applied as secondary reference.

Applicants further argue synergistic effects (Brief, page 11, 1st full paragraph)

This has been responded to (see OA p. 18-19)

The Examiner responds, as during prosecution :

*"In arguing the synergistic value of automation both to inserters and to client advertisers,
..., Applicants seems to suggest the references must be combined for the same purpose as
contemplated by the inventor. However, although the references do not disclose or suggest the
existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103, since the
references suggest a solution to problem; it is sufficient that references suggest doing what
applicants did, although they do not teach or suggest exactly why this should be done, other than
to obtain the expected superior beneficial results." In re Gershon, Goldberg, and Neiditch, 152
USPQ 602 (CCPA 1967). "...law of obviousness does not require that references be combined for
reasons contemplated by inventor, but only looks to whether some motivation or suggestion to
combine references is provided by prior art taken as whole. "In re Beattie, 24 USPQ2d 1040 (CA
FC 1992).*

*As to claim 6, nothing in the specifications require an interpretation that "an account
manager for the client" is an in-house person, and such a transmission of data is an in-house
one, absent specific definitions. Applicants are reminded of the broadest interpretation rule.
Nothing is claimed what this person will do with the information once he/she receives it so the
argument as to what this person might influence is unpersuasive. Even if "an account manager
for the client" is given weight, it would be just be interpreted as a person having some working
relationship with the client, in-house or outside. It is admitted that such a person having some
working relationship with the client receives report information manually (disclosure page 2).
As the admitted art in view of Rogers discloses automatic transmission of reports, it would*

have been obvious to automatically transmit to this same person as was done manually as well
for the same reasons: informing the relevant person.

... Applicants further seem to argue the collateral benefit of selling upgraded contracts
warrants patentability. However Applicants do not cite any precedent in support.

*Further it is noted the **claiming of a new use**, new function or unknown property which is*
inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562
F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). See MPEP 2112. Here selling upgraded
contracts may just be an obvious, inherent and collateral result of the improved communication
with clients which is a natural result from automatic generation of client reports. As stated
earlier automating the manual activity of generating client reports by computer just makes the
generation faster. It is natural more, and faster requested reports make clients happier."

Rogers is non-analogous art (Brief, page 11, 2nd full paragraph.

Applicants next argue Rogers is non-analogous art.

As stated in the OA at p. 16:

*However " a prior art reference is **analogous** if the reference is in the field of applicant's*
*endeavor **or**, if not, the reference is **reasonably pertinent** to the particular problem with which*
the inventor was concerned." In re Oetiker , 24 USPQ2d 1443, 1445 (Fed..Cir. 1992). Also
"Section 103 requires us to presume that the artisan has full knowledge of the prior art in his
field of endeavor and the ability to select and utilize knowledge from analogous arts."Lamont v.
Berguer, 7 USPQ2d 1580 (BdPatApp&Int 1988).

Rogers is analogous arts because one faced with the problem for pulling data from
different sources as the inventor faces would look to the solutions presented by workers in the
computer field such as Rogers."

Rogers does provide the deficiencies:

It must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977)."

Thus one skilled in the art with the teachings of Rogers and the admitted art would have known to make the proper system modifications to solve the automation problem facing the inventor.

Rogers does provide the pertinent teaching (Brief, page 12, 2nd full paragraph).

Applicants next argue Rogers does not teach how to reach into and retrieve data from any system.

As stated earlier, "

*This is clearly not the case. Rogers discloses "...**DIS servers ... retrieving, from a database gateway coupled to a plurality of database resources ...,requested information from multiple data bases located at different types of databases geographically dispersed,** performing calculations, formatting, and other services **prior to reporting to the web browser or to other locations, in a selected format, as in a display, fax, printer, and to customer installations** ...with account tracking." (abstract). Thus Rogers clearly teaches reaching into different databases of many systems to retrieve requested data.*

Further the instant claims do not claim how to reach into and retrieve data in any details either thus the argument is unpersuasive. The instant claims do not even claim pulling records from traffic and billing system software specifically, thus again the attacks on Rogers. are unpersuasive "

Applicants further argue Rogers is not enabling as to an automation application of TBS records in particular.

It is surmised Applicants require more flow charts or source code listings. However, "[a]s a general rule, where software constitutes part of a best mode of carrying out an invention, **description** of such a best mode **is satisfied by a disclosure of the functions** of the software. This is because, normally, **writing code for such software is within the skill of the art,** not requiring undue experimentation, **once its functions have been disclosed. . . . [F]low** charts or source code listings are not a requirement for adequately disclosing the functions of software." *Fonar Corp v. General Electric Co.,* 41 USPQ2d 1801, 1805. Further " ... **lack of diagrams, flow charts, and source codes in prior art publications did not render them non-enabling,** in view of fact that applicant's own specification fails to provide such detailed information and that one skilled in art would know of equipment and techniques to be used. *In re Epstein,* 31 USPQ2d 1817 (CA FC 1994). It is not clear in this instance, and Applicants have not pointed out, that Applicant's own disclosures are more enabling than Rogers's .

As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed.

It is well established that what is within the skill of the art need not be disclosed to satisfy the best mode requirement as long as that mode is described. Stating the functions of the best mode software satisfies that description test.

In summary as to Rogers,

Rogers is analogous art because, thought not in the field of applicant's invention, it is **reasonably pertinent** to the particular problem with which the inventor was concerned. One

faced with the problem for pulling data from different sources, as the inventor faces would look to the solutions presented by workers in the computer field such as Rogers.

Contrary to argument, it is well within the level of ordinary skill in the art as shown by Rogers (and the level of skill is very high as discussed above) to adapt the methods of Rogers to the instant problem of electronically accessing records of traffic and billing system software or the like and automation of client-oriented scheduled advertiser reports.

Though Rogers contains no specific teachings relating to traffic and billing system, Applicants have not shown how the method s of Rogers would be incompatible with the types of records produced by a traffic and billing. Applicants do not show how the relevant time windows for accessing the data and producing a report would be hindrance to application of Rogers.

It is clear the artisan would have been led to combine these teachings to automate the admittedly known manual data collection in a TBS environment if desired, based on the Rogers' teachings. Once this decision is made by the artisan, it must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

In applying the teachings of Rogers to the *admitted art, of manually accessing electronic TBS data records, reformatting them to generate a report and transferring such report,* the artisan would have known that one does not and cannot boldly substitute some system means for others but, rather, that modifications dictated by specific equipment would have been necessary. Again, it has been said, that the problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby. Thus, in adapting the electronic data collection, manipulation and transfer means of Rogers to the TBS environment, the artisan would have been well aware of the necessary modifications to Rogers in order to effect fitting to a TBS environment.

Not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F.2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Dovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985).

Thus it can be presumed that the artisan seeking to modify Rogers in order to fit to the situation of the admitted art, would have known to adjust the methods of Rogers in order to provide for the TBS data processing speed requirements if any. This was well within the skill of the artisan at the time of applicants' invention.

Secondary Evidence of Non-obviousness(Brief, pages 15-16)

a) Evidence of commercial success

Applicants argue commercial success **(Brief, page 15).** However, inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. *In re Huang,* 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996).

Further as stated earlier *", selling upgraded contracts may just be an obvious, inherent and collateral result of the improved communication with clients which is a natural result from automatic generation of client reports. As stated earlier · automating the manual activity of generating client reports by computer just makes the generation faster. It is natural more, and faster requested reports make clients happier. "*

b) Evidence of Copying and Failure of others.

Applicants argue Copying and Failure of others (Brief, page 16).

As to the facts argued, they do not show evidence of copying by others.

Evidence of copying is evidence that competitors (e.g. infringers) in the marketplace are copying the invention instead of using the prior art. See MPEP 716.06.

Further even if the lone programmer attempt can be viewed as "copying by others" "substantial length of time to design a product or process similar to the claimed invention" followed by failure and then copying of the claimed invention instead" needs to be shown. See *Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d 469, 2 USPQ2d 1350 (Fed. Cir. 1987).

Great effort, time and expense (e.g. 10 years of effort and expense, see below) need to be shown to be persuasive.

Alleged copying is not persuasive of nonobviousness when the copy is not identical to the claimed product, and the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). See also *Vandenberg v. Dairy Equipment Co.*, 740 F.2d 1560, 1568, 224 USPQ 195, 199 (Fed. Cir. 1984) (evidence of copying not found persuasive of nonobviousness) and *Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 1098-99, 227 USPQ 337, 348, 349 (Fed. Cir. 1985), *vacated on other grounds*, 475 U.S. 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987) (evidence of copying found persuasive of nonobviousness where admitted infringer failed to satisfactorily produce a solution after 10 years of effort and expense).

Here there is only evidence of failure of one lone programmer as competitor and no time, expense and effort evidence is proffered. Evidence of only one other competitor presently beta-testing (without results yet) only shows interest in solving the problem. Thus Applicants have not persuasively shown that the industry lack the technical know-how to solve the problem.

"The failure to solve a long-felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics Corp. of America*, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977).

(11) Related Proceeding(s) Appendix

None.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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